

## **REMARKS**

In response to the Official Action mailed February 27, 2004, Applicants have amended Claims 1, 21 and 41 to clarify that the profile document is forwarded to the server over the network path "so as to provide to the server a modified profile document containing information incorporated in the profile document at the client and information incorporated in the profile document by the network intermediary." Thus, the profile document provided to the server includes information incorporated in the profile document both by the client and by the network intermediary.

### **The IDS**

Applicants wish to bring to the Examiner's attention an IDS that was filed May 4, 2004 in the present case. Applicants request that the materials submitted with the IDS be considered by the Examiner and that an initialed copy of the PTO-1449 forms be returned with any subsequent communication in the present case.

### **The Claims Are Not Anticipated**

Claims 1, 2, 21, 22, 41 and 42 stand rejected under 35 U.S.C. § 102(e) as anticipated by United States Patent Application Publication No. US2001/0020242 to Gupta *et al.* (hereinafter "Gupta"). In particular, the Official Action cites to page 4, paragraph 53 as disclosing "incorporating in the profile document a designator which indicates that the profile information is not provided by the client and is provided by a network intermediary in a path between the client and the server." Official Action, pp. 2-3. The Official Action also cites to Gupta page 4, paragraph 57 as disclosing "transmitting the profile document with the designator from the client to the server utilizing the path." Official Action, p. 3.

Gupta describes a system where a proxy is used to maintain statistics on a user. Communications are routed through the proxy which collects profile information. *See* Gupta, pp. 4-5, ¶¶ 57-60. This collected profile information may be used to select targeted advertising to send to the user based on the profile information, to customize web pages, to generate e-mail, log sale profile information and/or to identify the user. *See* Gupta, pp. 5-7, ¶¶ 62-83.

Based on Applicants' review of Gupta, it does not appear that a profile document that is generated at a client has identifications incorporated into the document that identify information to be provided by a network intermediary. Furthermore, there does not appear to be any discussion in Gupta of a profile document that is generated at the client being modified by a network intermediary, such that the server receives the document with information incorporated in the document by the client **and** information incorporated in the document by a network intermediary. Accordingly, Applicants submit that at least the highlighted portions of Claim 1 are neither disclosed nor suggested by Gupta:

1. (Presently Amended) A method of providing profile information associated with a client to a server, the method comprising the steps of:  
generating, at the client, a profile document containing profile information associated with the client;  
**incorporating in the profile document a designator which indicates that profile information identified by the designator is not provided by the client and is provided by a network intermediary in a path between the client and the server; and**  
**transmitting the profile document with the designator from the client to the server utilizing the path so as to provide to the server a modified profile document containing information incorporated in the profile document at the client and information incorporated in the profile document by the network intermediary.**

Corresponding recitations are found in independent Claims 11 and 41.

With regard to the particular assertions in the Official Action, Applicants submit that assigning an IP address to a client as described in paragraph 53 of Gupta does not disclose or suggest incorporating a designator into a profile document where the designator identifies information that is not provided by the client but is provided by a network intermediary. Instead, the cited portion of Gupta merely describes assigning an IP address, even if the information is provided by another device in the network. Merely describing the assignment of an IP address does not describe a profile document or a designator that is incorporated in the profile document as recited in Claim 1.

Furthermore, the cited paragraph 57 of Gupta describes tracking web activity. It does not describe sending a document from a client to a server where the document has designators that identify information incorporated by the client and information incorporated by a network intermediary. As such, Applicants submit that Claims 1, 11 and 41 and the claims that depend from them are neither disclosed nor suggested by Gupta.

Claims 2, 12 and 42 are patentable as depending from a patentable base claim but are also separately patentable over Gupta. These claims each recite "a profile information identifier which identifies a type of profile information in the profile document and a wildcard designator associated with the profile information identifier which indicates that the type of profile information associated with the profile information identifier is provided by a network intermediary in the path between the client and the server." The Official Action does not even discuss this language. Based on Applicants review of the cited portions of Gupta, it does not appear that a plurality of distinct designators are discussed at all. As such, Applicants submit that Claims 2, 12 and 42 are separately patentable over Gupta for at least these additional reasons.

#### **The Claims Are Not Obvious**

Claims 3, 12-15, 19, 23, 32-35, 39, 43, 52-55 and 59 stand rejected as obvious under 35 U.S.C. § 103 in light of Gupta and United States Patent Application Publication No. US2002/0010776 to Lerner (hereinafter "Lerner"). Claims 3, 12 and 13 are dependent claims that dependent from Claim 1. Claims 23, 32 and 33 are dependent claims that dependent from Claim 21. Claims 43, 52 and 53 are dependent claims that dependent from Claim 41. Applicants submit that these claims are patentable at least as depending from a patentable base claim. Claims 14, 34 and 54 are independent claims and the remaining claims depend from these claims. Accordingly, Applicants will first address the Section 103 rejections of the independent claims and then address dependent claims that provide separate grounds for patentability.

The Official Action cites to no additional portions of Gupta as disclosing any of the recitations of the rejected claims. The Official Action cites to Lerner, page 7, paragraph 67 as teaching each of the recitations of Claims 13-15, 19, 33-35, 39, 53-55 and 59 that are missing from Gupta. As the motivation for combining the references, the Official Action states that Gupta and Lerner would be combined "in order to update the user cookie profile to reflect the user event based on the message received." Official Action, p. 4.

To establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *See* M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See* M.P.E.P. § 2143.01(citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). As emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be clear and particular, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In another decision, the Court of Appeals for the Federal Circuit has stated that, to support combining or modifying references, there must be particular evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

Furthermore, as stated by the Federal Circuit with regard to the selection and combination of references:

This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion....

*In re Sang Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

Applicants submit that the pending claims are patentable over the cited references because the cited combination fails to disclose or suggest the recitations of the pending claims and the reasoning behind such combination has not been established.

14. (Original) A method of providing client profile information to a server, the method comprising the steps of:  
**receiving, at a network intermediary, a profile document from a client for forwarding to the server;**  
determining if a portion of the profile document is encrypted;  
decrypting the encrypted portion of the profile document;  
**parsing the decrypted portion of the profile document to determine if a designator is provided in the decrypted portion of the profile document which**

**indicates that profile information identified by the designator is to be incorporated into the profile document by the network intermediary; incorporating the identified profile information in the profile document so as to provide a modified profile document; and transmitting the modified profile document to the server.**

Corresponding recitations are found in independent Claims 34 and 54. Applicants submit that at least the highlighted portions of Claim 14 are not disclosed or suggested by the cited portions of Gupta and Lerner.

In particular, as discussed above with reference to Claim 1, the cited portion of Gupta does not disclose or suggest a profile document, forwarding a profile document from a network intermediary to a server, incorporating profile information in the profile document or transmitting the modified profile document to a server as is recited in Claim 14. The cited portions of Gupta describe assigning an IP address to a client and using a proxy to track user activity.

Likewise, the cited portion of Lerner describes decrypting a message and providing the decrypted message to a database. There is no discussion of "parsing the decrypted portion of the profile document to determine if a designator is provided in the decrypted portion of the profile document which indicates that profile information identified by the designator is to be incorporated into the profile document by the network intermediary" as recited in Claim 14. Furthermore, there is no disclosure or suggestion in the cited portion of Lerner that portions of a document that contain designators that profile information is provided by a network intermediary be encrypted. As such, Applicants submit that the cited portion of Lerner fails to disclose or suggest each of the recitations of Claim 14.

Furthermore, the motivation to combine cited in the Official Action is merely a conclusory allegation and is based on an incorrect interpretation of the cited references. For example, Gupta does not disclose the use of an intermediary as recited in Claim 14. The cited portion of Lerner does not disclose "updating the profile at the intermediary" as stated in the Official Action but discloses updating a cookie profile at the server based on a received message. Therefore, even if combined, the Official Action has not established that the combination of Gupta and Lerner would result in the recitations of Claim 14. In any event, the cited motivation to combine is merely a conclusory assertion that the references would be combined and provides not reason why.

In light of the above discussion, Applicants submit that Claim 14 is patentable over the cited references. Claims 34 and 54 include similar recitations and, therefore, are patentable for analogous reasons. Applicants also submit that the dependent claims are patentable at least as per the patentability of their respective base claims and for reasons analogous to those discussed above with reference to Claim 2.

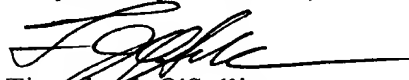
Claims 4-11, 16-18, 20, 24-31, 36-38, 40, 44-51, 56-58 and 60 stand rejected as obvious under 35 U.S.C. § 103 in light of Gupta, Lerner and United States Patent No. 6,205,553 to Stoffel *et al.* (hereinafter "Stoffel"). Applicants submit that these claims are patentable at least as per the patentability of their respective base claims. Furthermore, Applicants submit that a prima facie case of obviousness has not been established for many of these claims as the Official Action merely ignores the differing recitations of these claims and equates encrypting a random number in Stoffel with all of the various recitations of Claims 4-11, 16-18, 24-31, 36-38, 44-51 and 56-58. As such, Applicants submit that these claims are separately patentable for at least these additional reasons.

In re: Hild, et al.  
Serial No.: 09/533,644  
Filed: March 22, 2000  
Page 20 of 20

### Conclusion

Applicants respectfully submit that the pending claims are in condition for allowance, which is respectfully requested in due course. It is not believed that any extension of time is required for this paper. However, in the event that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned under 37 C.F.R. §1.136(a). Any additional fees believed to be due in connection with this paper may be charged to our Deposit Account No. 09-0461.

Respectfully submitted,

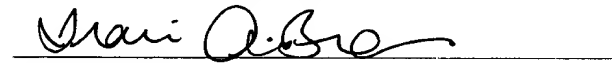


Timothy J. O'Sullivan  
Registration No. 35,632

✓ **USPTO Customer No. 20792**  
Myers Bigel Sibley & Sajovec  
Post Office Box 37428  
Raleigh, North Carolina 27627  
Telephone: 919/854-1400  
Facsimile: 919/854-1401

### Certificate of Mailing under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Non Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 19, 2004.

  
Traci A. Brown